

REMARKS

This application has been amended in a manner that is believed to place it in condition for allowance at the time of the next Official Action.

Claims 25-26 and 28-35 are pending in the present application. Claims 25-26, and 28-34 have been amended to address the formal matters raised in the outstanding Official Action. Claims 1-24 and 35 have been canceled.

In the outstanding Official Action, claims 20 and 35 were objected to for containing several informalities. However, as noted above, claims 20 and 35 have been canceled. As a result, applicants believe that the objection has been obviated.

Claims 30 and 33 also were objected to for containing several informalities. However, claims 30 and 33 have been amended as suggested by the Examiner. As a result, applicants respectfully request that the objection be withdrawn. At this time, applicants would like to thank the Examiner for his suggestions as to how to overcome these objections.

Claims 20-26 and 28-35 were rejected under 35 USC §112, second paragraph, for allegedly being indefinite. This rejection is respectfully traversed.

As noted above, claims 20-24 and 35 have been canceled. Thus, applicants believe that the rejections related to these claims have been obviated.

As to claims 25, 28, and 30-32, applicants believe that the claims have been amended in a manner so as to obviate these rejections. In particular, applicants note that claim 25 has been amended to further clarify the definition for the "R" groups. In view of the amended definition for the R groups, applicants believe that claim 25 is definite to one skilled in the art.

Additionally, as suggested by the Examiner, the term "corresponding to the number" has been deleted from claim 25. As a result, applicants believe that this rejection has been obviated.

Claim 28 was rejected for depending from a canceled claim. However, claim 28 has been amended to depend from pending claim 25.

Claims 30-32 were rejected for reciting method steps which were not in accordance with the purpose set forth in the preamble. However, applicants believe that claims 30-32 have been amended in a manner so as to clarify that the method is directed to the *in vitro*, *ex vivo*, or *in vivo* intracellular transfer of oligonucleotides into a cytosol and/or into a cell nucleus of a cell.

Thus, in view of the above, applicants believe that the pending claims are definite to one skilled in the art.

Claims 20-24 and 29-35 were rejected under 35 USC §112, first paragraph, for allegedly not satisfying the written description requirement. Claims 20-24 and 28-35 were rejected under 35 USC §112, first paragraph, for allegedly not satisfying the enablement requirement. Applicants believe that the present amendment obviates these rejections.

As noted above, claims 20-24 and 35 have been canceled. While claims 28-34 are still pending in the present application, the claims have been amended so they depend from claims 25 and 26. As a result, applicants believe that these rejections have been obviated. As a result, applicants respectfully request that the rejection be withdrawn.

Claims 20-26 and 33-35 were rejected under 35 USC §103(a) for allegedly being unpatentable over MIDOUX et al. This rejection is respectfully traversed.

As noted above, claims 20-24 and 35 have been canceled. Claims 25-26 and 28-35 are pending in the present application. Thus, applicants note that pending claims 28-33 are not subject to the rejection and respectfully request that the these claims be allowed.

In imposing the rejection, the Office Action states that the WO 98/22 610 publication is directed to DNA transfection. However, the present invention is appropriate for oligonucleotide transfection. As a result, applicant believes

that the teaching of the WO 98/22 610 publication does not provide the motivation for one skilled in the art to modify its teachings to select a degree of polymerization and a percentage of substitution of oligomers as set forth in the present invention.

Indeed, the Examiner is respectfully reminded that a particular parameter or variable must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the parameter or variable might be characterized as routine or obvious. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). See also *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). As the teaching of the WO 98/22 610 publication does not provide the motivation for one skilled in the art to modify its teachings to select a degree of polymerization and a percentage of substitution of oligomers as set forth in the present invention, applicants believe that the WO 98/22 610 publication fails to render obvious the claimed invention.

Moreover, applicants note that a critical step in analyzing obviousness pursuant to 35 U.S.C. §103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, only guided by the publications and then-accepted wisdom in the field.

Close adherence to this methodology is important in cases where the invention itself may prompt an Examiner to "fall victim to the insidious effect of a hindsight syndrome, wherein that which only the invention taught is used against its teacher." Indeed, to establish a prima facie case of obviousness, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ 2d 1313, 1362 (Fed. Circ. 2000). The fact that the prior art could be so modified would not have made the modification itself obvious unless the cited publications themselves suggested the desirability of the modification. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Circ. 1984).

As the teaching of the WO 98/22 610 publication does not provide the motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant, applicants believe that the WO 98/22 610 publication fails to render obvious the claimed invention.

Claims 20-26 and 33-35 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being obvious claims 1-6 and 10-15 of U.S. Patent 6,372,499. This rejection is respectfully traversed.

At this time, the Examiner's attention is respectfully directed to the terminal disclaimer attached with this amendment. In view of the terminal disclaimer, applicants believe that double patenting rejection has been obviated.

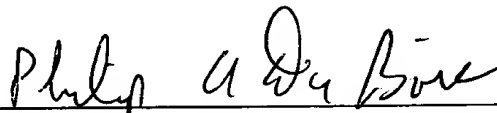
In view of the present amendment and the foregoing remarks, therefore, it is believed that this application is now in condition for allowance, with claims 25-26 and 28-34, as presented. Allowance and passage to issue on that basis are accordingly respectfully requested.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following item(s):

- a terminal disclaimer